REMARKS

I.   Introduction

In response to the Office Action dated November 3, 2004, the claims have not been amended. Claims 1-18 remain in the application. Re-examination and re-consideration of the application, as amended, is requested.

II.   Double Patenting Rejection

On page 2, paragraphs (1)-(2) of the Office Action, claims 1-18 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,675,355.

In accordance with the recommendation in the Office Action, enclosed is a terminal disclaimer to overcome the double patenting rejection. In view of the terminal disclaimer, Applicants submit the rejection is now moot.

III.   Prior Art Rejections

On page 3, paragraphs (1)-(3) of the Office Action, claims 1-18 were rejected under 35 U.S.C. §103(a) as being unpatentable over Lee et al., U.S. Patent No. 6,480,865 (Lee) in view of Schilit et al., U.S. Patent No. 6,279,014 (Schilit).

Specifically, the independent claims were rejected as follows:

> Regarding claims 1, 7, 13, Lee et al. teaches a method of annotating (which is equivalent to redlining/marking) the XML document as described in the abstract, line 1. Accessing RedlineXML document (fig 2, element 202) that confirms to RedlineXML schema (col. 2, lines 10-19), wherein the schema identifies the structure of the XML document (col. 2, lines 17-20) comprising:
>
> A base document element that identifies a base document (col. 5, lines 1-5, & fig. 2, element 206) and
>
> Object element comprising one or more attributes for displaying markup object (fig 2, element 210, col. 2, lines 37-44, col. 5, lines 60-col. 6, lines 15, wherein the Java class object comprises one or more attributes for markup object).

Applicants traverse the above rejections for one or more of the following reasons:

(1)   Neither Lee nor Schilit teach, disclose or suggest an XML schema for redlining/marking up a base document;

(2)   Neither Lee nor Schilit teach, disclose or suggest a basic document element within the XML document that identifies a base document;

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(3)   Neither Lee nor Schilit teach, disclose or suggest an object element within the XML document that comprises attributes for displaying a redline markup object on a base document identified in the XML document; and

(4)   Neither Lee nor Schilit teach, disclose or suggest displaying a redline markup object on a base document based on the elements specified in the XML document.

Independent claims 1, 7, and 13 are generally directed to displaying a redline markup object on a document based on an XML document that complies with an XML schema. Specifically, the XML document has at least two elements. The first element is a base document element that specifies a base document to be marked up. The second element is an object element that has one or more attributes. The one or more attributes are for displaying a redline markup object on the specified base document. The claims then provide for displaying the redline markup object on the specified base document in accordance with the object element and the attributes.

The cited references do not teach nor suggest these various elements of Applicants' independent claims.

Lee merely describes a method for annotating eXtensible Markup Language (XML) documents with dynamic functionality. The dynamic functionality comprises invocations of Java objects. These annotations belong to a different name space, and thus a Dynamic XML-Java (DXMLJ) processor recognizes elements within the XML document that are tagged with DXMLJ prefix tags, processes each of these tags, and transforms the XML document accordingly.

However, unlike the present claims, Lee utilizes the terminology "markup" to identify the XML constructs and the tags within the XML document itself. For example, col. 2, lines 10-17 provides:

> An XML document has two parts: (1) the marked up document; and (2) the document schema. XML documents are made up of storage units called entities, which contain either parsed or unparsed data. Parsed data is made up of characters, some of which form character data, and some of which form markup. Markup encodes a description of the document's storage layout and logical structure.

As can be seen by this text, Lee feels that the XML document is the "marked up document". Lee's invention is directed towards annotating (with dynamic functionality) the XML document itself (see col 4, lines 8-9). Lee then states that the dynamic functionality are invocations of Java objects. Further, the dynamic functionality is readable by a special Dynamic XML-Java (DXMLJ)

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processor that is configured to recognize elements within the XML document that are tagged with DXMLJ prefix tags (see col. 4, lines 9-15).

The portions of Lee that are cited in the Office Action merely reinforce the description above. For example, col. 5, lines 60-col. 6, line 15 describes the various prefixes within Lee's XML document that can be used to change the XML document itself.

In view of the above, it is clear that Lee doesn't even remotely describe the process of marking up a base document using redline text based on information cited within an XML document (that complies with an XML schema) as claimed. As described above, the first claim limitation provides that the XML document contains an element that specifies a base document. Thus, the element within the XML document specifies a base document. In this regard, the element is not the XML document itself. Instead, it is an element within the XML document. In rejecting this element, the claims rely on col. 5, lines 1-5 and fig. 2, element 206. Col. 5, lines 1-8 provide:

> A Dynamic XML-Java (DXMLJ) processor 112 recognizes elements within a XML document 114 that are tagged with "dxmlj" prefix tags, processes each of these tags, and transforms the XML document 114 accordingly. This processing may include the instantiation of one or more Java class specifications 116 as Java objects 118, wherein the Java class specifications 116 and Java objects 118 comprise functions that transform the XML document 114.

In addition, item 206 of figure 2 is merely a question in a flow chart that provides "DXMLJ PREFIX TAG?". Such text and figure completely fail to teach, describe, or suggest, implicitly or explicitly, an element within an XML document that identifies a base document. Instead, the text describes in XML document that has various elements that are tagged with "dxmlj" prefix tags that are used to transform the XML document. However, the concept of identifying a base document in one of the elements is not even alluded to in the recited text (or the remainder of Lee).

The second element provides for an object element (within the XML document) that has one or more attributes for displaying a redline markup object on the base document that is identified by the base document element. In rejecting this element, the Office Action relies on fig. 2, element 210, col. 2, lines 37-44, and col. 5, lines 60-col. 6, line 15. Element 210 of Fig. 2 is merely a step in a flow chart that provides "INVOKE JAVA OBJECT". Col. 2, lines 37-44 is background material and describes five basic constraints (i.e., general concepts) of an XML schema. The description provides that attributes of an element may have values and determine whether the attributes are

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optional or mandatory. The description in col. 5, line 60-col. 6, line 15 describes the various prefixes that may be used in Lee. One such prefix uniquely identifies an annotation element.

However, notoriously absent from any of the cited text (and the remainder of Lee) is any description, implicit or explicit, of the ability to markup a base document (that is not the XML document) using a redline object. Instead, as stated above, the annotations described in Lee are specifically for the purpose of dynamically changing and transforming Lee's XML document itself. In this regard, Lee's annotation element does not have attributes for displaying a redline object on a base document that is identified in another element of the XML document. In other words, the claims specifically provide that the redline markup object is displayed on the base document identified through an element in the XML document. No such interrelationship between an annotation or base document even remotely exists in Lee.

In addition, the markup object is a "redline markup object". The term "redline" has a particular meaning and cannot merely be ignored when evaluating the claims. Under MPEP §2142 and 2143.03 "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)." The claims use the word "redline" which cannot be ignored. In this regard, the markup object is a redline or edit that is displayed on a base document. A "redline" as used in the claims, the specification, and as understood in the art, is a markup of a document, drawing, etc. Fig. 5 and page 17, lines 1-9 (paragraph [0049]) clearly describe what a "redline" may consist of. Further, the American Heritage Dictionary defines "redline" as "*Computer Science.* To mark or highlight edited text, as with a red line, to distinguish it from unedited portions of a document." (see http://dictionary.reference.com/search?q=redline). In view of the definition in either the specification or the dictionary, Lee's annotations do not even remotely describe a "redline" as claimed.

The last claim element provides for displaying the redline markup object on the specified base document in accordance with the object element and attributes. The Office Action admits that Lee fails to teach this element and relies on Schilit instead.

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Schilit merely describes a document organizing system that extracts annotations made to a document along with the context surrounding each annotation and organizes the annotations based upon the annotation attributes and/or context. The annotations are created by grouping marks based upon their proximity in time and space. The document is segmented to determine a minimum context associated with each annotation. A list of the annotations sorted by the attributes are then displayed to the user. The context provided by Schilit for each annotation allows the user to fully understand the annotation.

However, Applicants note that Schilit completely fails to describe XML, an XML document, an XML schema. Even further, Schilit fails to describe HTML or web based documents. In fact, separate electronic searches of Schilit for the terms "web", "HTML", and "XML" provided no results whatsoever. Without even remotely referring to these explicit limitations of the claims, Schilit cannot possibly render the claims nonobvious. In addition, Applicants submit that since the present application specifically involves using an XML schema to markup a document in an web/internet environment, Schilit is in an unrelated field. The MPEP §706.02(j) provides that "there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." There is no suggestion or motivation in either Lee or Schilit to combine Lee with Schilit or vice versa. Further, the level of ordinary skill in the art would not lead someone to modify or combine Lee with Schilit. In this regard, Lee related to transforming an XML document itself while Schilit relates to a document organization system. Such fields of invention are entirely separable.

The motivation to combine the references in the Office Action was to provide flexible organization of material without adding effort of reading and note taking as described by Schilit. However, such an advantage merely exists to markup a document and has nothing to do with an XML schema or marking up documents based on an XML schema as set forth in the claims. Accordingly, the relied upon motivation fails to meet the requirements set forth in the MPEP and rules for combining the references.

In addition to the above, Applicants submit that while Schilit describes displaying an annotation to a user, Schilit completely fails to describe displaying an annotation based on attributes specified in an XML document. Further, Schilit completely fails to describe displaying such

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annotations on a base document that is specified via an element in an XML document. The rejection attempts to separate the interrelated elements of the claims using an obviousness type rejection. However, one cannot evaluate the application in individual elements but must examine the application and claims as a whole (see MPEP §2142). The relationship of the individual claim elements and the claims as a whole must be examined. The prior art and the Office Action fails to evaluate or even consider the relationship between the elements and does not examine the claim as a whole.

Further, since the cited references are not related, it would be impossible to combine the references to produce a working product. In this regard, Lee would provide for a dynamic XML document that has tags recognized by a special XML processor, while Schilit would provide the ability to organize annotations for a document. There is no relation between them and they cannot be combined to produce or teach the properties or claim limitations as asserted in the Office Action.

Moreover, the various elements of Applicants' claimed invention together provide operational advantages over Lee and Schilit. In addition, Applicants' invention solves problems not recognized by Lee and Schilit.

Thus, Applicants submit that independent claims 1, 7, and 13 are allowable over Lee and Schilit. Further, dependent claims 2-6, 8-12, and 14-18 are submitted to be allowable over Lee and Schilit in the same manner, because they are dependent on independent claims 1, 7, and 13, respectively, and thus contain all the limitations of the independent claims. In addition, dependent claims 2-6, 8-12, and 14-18 recite additional novel elements not shown by Lee and Schilit.

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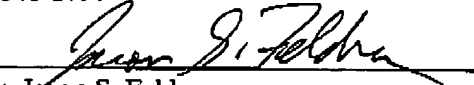G&C 30566.103-US-C1

IV. Conclusion

In view of the above, it is submitted that this application is now in good order for allowance and such allowance is respectfully solicited. Should the Examiner believe minor matters still remain that can be resolved in a telephone interview, the Examiner is urged to call Applicants' undersigned attorney.

Respectfully submitted,

GATES & COOPER LLP
Attorneys for Applicant(s)

Howard Hughes Center
6701 Center Drive West, Suite 1050
Los Angeles, California 90045
(310) 641-8797

Date: February 1, 2005

By:_____
Name: Jason S. Feldmar
     Reg. No.: 39,187

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